

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on April 13, 2004. Claim 1-10 are pending in this Application and Claim 1 stands rejected. Claim 1 is amended and new Claims 2-10 are added by the present Amendment.

Summarizing the outstanding Office Action, Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Baumann (U.S. Patent No. 3,684,136, hereinafter "Baumann") in view of Osanai et al. (U.S. Patent No. 5,026,283, hereinafter "Osanai") and Magnusson et al. (U.S. Patent No. 5,370,221, hereinafter "Magnusson"). Claim 1 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,682,347 (hereinafter the '347 patent) in view of Magnusson.

Applicants thank the Examiner for the courtesy of an interview extended to Applicants' representative on May 25, 2004. During the interview, Amendments to the claims as herein presented were proposed, and arguments as hereinafter developed were presented.

Applicants' representative argued during the interview that there was no motivation to add an air-permeable filter in the inventions of Baumann or Osanai because both references taught against such an approach for at least three reasons. First, both are silent with respect to the problem associated with air entrainment in the mixture as discussed in Applicants' specification.¹ Secondly, both references teach against air permeability because both systems

¹ See, for example, specification, page 7, lines 9-21.

are air tight,^{2,3} i.e., only after the mixing process is when the capsules are either opened or punctured. Thirdly, given the sealed nature of the capsules of Baumman and Osanai, one of ordinary skill in the art, considering the non-analogous art of Magnusson, would not be motivated to place the filter element of Magnusson in the devices of Baumman and/or Osanai because, in view of their air-tight characteristics, such a modification would be useless since the only place for the location of the filter element of Magnusson would be outside of the air-tight capsules, i.e., inside element 56 of Baumman or element 4a of Osanai as incorrectly suggested during the interview. An agreement was not reached during the interview.

However, as indicated in the personal interview summary (form PTOL-413), the Examiner, Mr. John J. Wilson, indicated that "it was argued that the prior art does not show locating the filter in the nozzle so that air will escape through the nozzle and that this is a patentable distinction over the claims of the parent application because of advantages. This distinction, if added to the claims appears to overcome the combination of the references and may overcome the double patenting rejection, the examiner will review the references and claims of the parent application upon filing of the amendment."

Claim 1 has been amended to recite that "the air-permeable filter is configured to allow air to escape from the mixing compartment through the nozzle." Based at least on the foregoing discussion and the results of the personal interview, Applicants respectfully submit that the above-summarized rejections are now moot. Their withdrawal is respectfully requested.

As to the obviousness-type double patenting rejection, Magnusson is no longer applicable in view the instant amendment to Claim 1. In addition, Claim 1 would not be

² In Baumann, see, for example, the teaching that the relative portion 55 is pierced from below, with the aid of a pointed metal tool, when the ready mixture is to be discharge from the receptacle (Baumann, col. 8, lines 54-61). In addition, in Baumann, all of the embodiments are air tight until the end of the mixing process.

³ In Osanai, see, for example, the specific teaching that only when the breakable package is damage is that the mixed tooth-restoring material passes through the plastic coated aluminum material foil between the mixing chamber of Osanai and the sealed nozzle 4.

obvious in view of the claims of the '347 patent because of the advantage, among others, that placement of the air-permeable filter in the nozzle eliminates the need to have an additional orifice on the side wall of the mixing compartment. As explained in Applicants' specification,⁴ placement of the air-permeable filter in the side wall of the container requires an aperture window. In the instant invention, the same effect is accomplished, i.e., removal of air from the mixture in the mixing compartment, without the need to provide the additional orifice or aperture window, i.e., with a reduction on the number of parts.⁵

Finally, Applicants have submitted herein new Claims 2-10, depending from Claim 1. Support for the subject matter of the new claims is found, for example, on pages 9, lines 6-22, page 18, lines 11-24, and on page 22, lines 22-24 of Applicants' specification. No new matter has been added to this Application by the submission of new Claims 2-10. Claims 2-10, in view of their dependency from Claim 1, patently distinguish over Baumann, Osanai, and Magnusson.

Applicants note with appreciation the indication that the drawings filed on July 3, 2003 have been found acceptable and that our claim for priority under 35 U.S.C. § 119(a)-(d) has been received and placed on the record.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-10 is earnestly solicited.

⁴ See, for example, specification, page 16, line 5 – page 17, line 16.

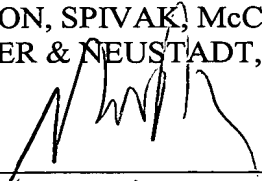
⁵ See, for example, MPEP §2144.04 (II)(B), noting "that the omission of an element and retention of its function is an indicia of unobviousness when citing *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966).

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Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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